

REMARKS

1. **Rejection of claims 12 and 17 under 35 USC 112, 2nd paragraph.**

Claims 12 and 17 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The deletion of claim 12 and 17 is believed to render this rejection moot.

2. **Rejection of claims 1, 3-4, 9-12 as anticipated under 35 USC 102(b) by Leach, U.S. Patent No. 5,338,578, hereafter "Leach" or "'578".**

The PTO's basis for the instant rejection is as follows:

Leach discloses a molded substrate comprising a first coating powder film with a second coating applied to the first film (abstract) having a thermally curable coating while heating the powder coating to initiate crosslinking (column 5, lines 15-25). Leach teaches the powder coating will melt and flow out on the substrate (column 5, lines 911). The reference discloses drying the coated substrate (column 6, lines 5-10).

(Office Action of 7/5/02, page 3)

Applicants appreciate the detailed basis of rejection but must respectfully disagree in regards to amended claim 1.

Claim 1 has been amended to better define the claimed invention. Support for this amendment may be found throughout the Application, but especially in original claim 5, now deleted, page 6, lines 4-25, page 29, lines 4-20 and 27-29 and page 30, lines 1-3.

Leach requires that the substrate to be coated in accordance with the invention of the '578 patent be preformed low density plastic substrates such as compression molded fiberglass reinforced polyester types known in the art as bulk molding compounds (BMC) or sheet molding compounds (SMC).

In contrast, Applicants' claimed invention relates to coated films wherein the support layer is selected from the group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film.

"[t]o constitute anticipation, all material elements of the claim must be found in one prior art source." In re Marshall, (CCPA 1978) 577 F.2d 301, 198 USPQ 344. This standard is not met with the '578 patent. In particular, Leach fails to disclose the use of a support film selected

from the group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film.

Accordingly, reconsideration and removal of the rejection is respectfully requested.

- W 3. **Rejection of claims 1-2, 6, 8, and 15 under 35 USC 103(a) as obvious over Leach, U.S. Patent No. 5,338,578, hereafter "Leach" or "578".**

Although the PTO admits that Leach does not disclose the thickness of the substrate or powder coatings. However, it is the PTO's position that:

The thickness of the substrate is an optimizable feature as it controls the flexibility of the film. It would have obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves routine skill in the art.

(Office Action of 7/5/02, page 4)

Applicants appreciate the detailed basis of rejection but must respectfully disagree, especially with respect to amended claim 1.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP 2143*

This standard is not met with Leach. In particular, nothing in Leach teaches or suggests the use of a support film selected from the group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film. Limitations in claims distinguishing over the prior art cannot be ignored. *In re Boe et al.*, 184 USPQ 38 (CCPA 1974)

Moreover, nothing in Leach suggests the use of such as a support layer in place of the SMC or BMC. Even if the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed Cir. 1989).

Accordingly, reconsideration and removal of the rejection is respectfully requested.

- W 4. **Rejection of claim 7 as obvious under 35 USC 103(a) over Leach, U.S. Patent No. 5,338,578, hereafter "Leach" or "578" in view of Craun et al., U.S. Patent No. 6,184,281, hereafter "Craun" or "281".**

The PTO relies upon Leach for claims 1-4, 6, 8-12 and 15-16. It is admitted that Leach does not disclose a removable film. Craun is relied upon for the disclosure of a coating composition suitable for coating plastic substrates where the coatings are easily removable and are made of powder coatings. It is the PTO's position that it would have been obvious to one of ordinary skill in the art to include the removable coating (film) to at least one powder coating layer of Leach because Craun teaches the removable coatings are recyclable and are therefore environmentally safe.

Once again, Applicants appreciate the detailed basis of rejection but must respectfully disagree. Rather, Applicants respectfully submit that the invention of dependent claim 7 is patentable over the combination of Leach and Craun for several reasons.

First, claim 7 is dependent upon amended independent claim 1 and thus incorporates all of the limitations therein. As noted above, Leach does not anticipate or render obvious the invention of independent claim 1. In particular, Leach fails to teach or suggest a support film selected from the group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film.

Craun does nothing to rectify the deficiencies of Leach. Rather, Craun discloses a coating composition for use on plastic articles which is removed by the caustic solutions used to recycle the plastic articles. The coating composition itself is not recyclable.

As a result, the cited combination fails to provide a prima facie case of obviousness as to the invention of dependent claim 7, which necessarily incorporates the limitations of amended independent claim 1.

Reconsideration and removal of the rejection is respectfully requested.

5. **Rejection of claim 1-5, 9, 11, 13-14, and 16-17. as anticipated under 35 USC 102(b) by EP 0844286, hereafter "286"¹ or "Muthiah" or "US'473".**

EP '286 is said to disclose filmed powder coating for substrates made of plastics (abstract) where the coatings are dry and free flowing and have a melt temperature of 200F. EP '286 is further cited for the disclosure of thermally cured powder coatings comprising a crosslinker where the substrates are used as furniture, which are domestic appliances.

Applicants must respectfully disagree with the PTO's interpretation of Muthiah. The '473 patent discloses opaquely pigmented or thick filmed powder coatings for heat sensitive

not of
based on
-473

substrates such as wood, wood composites, and plastics. The powder coatings are cured by a dual cure system comprising a thermal initiator and a UV initiator. Muthiah teaches that examples of heat sensitive substrates include

....wood, such as hardwood, hard board, laminated bamboo, wood composites, such as particle board, electrically conductive particle board, fiber board, medium density fiber board, masonite board, laminated bamboo, and other substrates that contain a significant amount of wood. Any of these wood based substrates may be filled or primed with materials such as UV liquids, powder primers, or solvent or waterborne coatings to improve smoothness and reduce film builds....Other heat sensitive substrates are plastics, such as ABS, PPO, SMC, polyolefins, acrylics, nylons and other copolymers which will usually warp or outgas when coated and heated with traditional heat curable powders. The plastics are typically used in automotive parts. Still other heat sensitive substrates include paper, cardboard, and composites and components with a heat sensitive aspect and the like.

(US 5,922,473, col. 16, lines 21-40)

Thus, Muthiah does not disclose coated films which can be rolled up and have a support layer having film thickness of from 10 to 1000 μm . - option
self-supporting paint film.

"[t]o constitute anticipation, all material elements of the claim must be found in one prior art source." In re Marshall, (CCPA 1978) 577 F.2d 301, 198 USPO 344. This standard is not met with the '473 patent. Rather, Muthiah teaches hard inflexible substrates and is silent as to any need for flexibility in the heat sensitive substrate.

Accordingly, reconsideration and removal of the rejection is respectfully requested.

6. **Rejection of claim 1-5, 9, 11, 13-14, and 16-17. as anticipated under 35 USC 102(b) by EP 0844286, hereafter "'286"² or "Muthiah" or "US'473" in view of Craun et al., U.S. Patent No. 6,184,281, hereafter "Craun" or "'281".** 105

The cited combination of Muthiah and Craun appears to be based on the PTO's foregoing statements regarding EP'286 and Craun.

Applicants appreciate the detailed basis of rejection but must respectfully disagree.

In particular, Applicants note the cited combination fails to rectify the above noted deficiencies of Muthiah.

¹ Applicants are relying upon the English language equivalent US 5,922,473, a copy of which is submitted herewith.

² Applicants are relying upon the English language equivalent US 5,922,473, a copy of which is submitted herewith.

That is, Craun's application of a strippable powder coating to plastic articles fails to provide any motivation to obtain a coated film capable of being rolled up. In short, none of the cited provide a film as is provided in Applicants' claimed invention. Limitations in claims distinguishing over the prior art cannot be ignored. *In re Boe et al.*, 184 USPQ 38 (CCPA 1974)

Accordingly, it is respectfully submitted that the cited combination fails to provide a prima facie case of obviousness. Reconsideration and removal of the rejection is respectfully requested.

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MARKED-UP VERSION OF AMENDMENTS

Please make the following amendments in the Application. Insertions are noted with underlined text and deletions are identified by brackets, i.e., [].

IN THE CLAIMS:

Please delete claims 5, 12 and 17. Please amend the remaining claims as follows:

1. (Twice Amended) A film comprising at least one support layer and one or more coating layers, wherein

the support layer is coated with at least one of the one or more coating layers,

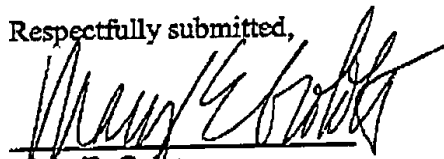
the support layer has a film thickness of between 10 and 1000 μm and is selected from the group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film,

at least one of the one or more coating layers comprises a thermally curable powder coating or a thermally curable powder coating dispersion, and

the claimed film is [flexable enough] to be rolled up.

capable

Respectfully submitted,



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